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DATE: August 4, 2008

PTO IDENTIFIER: Application Number 09/975,945-Conf. #9612
Patent Number

Inventor: Charles Paclar

MESSAGE TO: US Patent and Trademark Office

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FROM: FULBRIGHT & JAWORSKI L.L.P.

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Attorney Dkt. #: NY-THEOR 205-US1 (10107436)

PAGES (Including Cover Sheet): 28

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 Appeal Brief (23 pages)
 Appeal Brief Transmittal (1 page)
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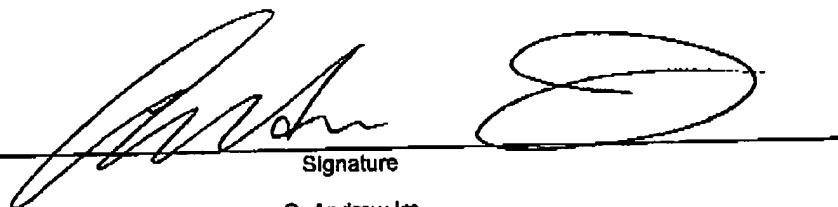
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Attorney Docket No.: NY-THEOR 205-US1

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Effective on 12/08/2004. Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818). FEE TRANSMITTAL For FY 2008		Complete If Known	
		Application Number	09/975,945-Conf. #9812
		Filing Date	October 11, 2001
		First Named Inventor	Charles Paclat
		Examiner Name	A. Khatri
<input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27		Art Unit	2191
TOTAL AMOUNT OF PAYMENT (\$)		Attorney Docket No. NY-THEOR 205-US1	

METHOD OF PAYMENT (check all that apply)					
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FEE CALCULATION**1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

<u>Application Type</u>	<u>FILING FEES</u>		<u>SEARCH FEES</u>		<u>EXAMINATION FEES</u>		<u>Fees Paid (\$)</u>
	<u>Fee (\$)</u>	<u>Small Entity Fee (\$)</u>	<u>Fee (\$)</u>	<u>Small Entity Fee (\$)</u>	<u>Fee (\$)</u>	<u>Small Entity Fee (\$)</u>	
Utility	310	155	510	255	210	105	
Design	210	105	100	50	130	65	
Plant	210	105	310	155	160	80	
Reissue	310	155	510	255	620	310	
Provisional	210	105	0	0	0	0	

2. EXCESS CLAIM FEES**Fee Description**

Each claim over 20 (including Reissues)

50 25

Each independent claim over 3 (including Reissues)

210 105

Multiple dependent claims

370 185

<u>Total Claims</u>	<u>Extra Claims</u>	<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>	<u>Multiple Dependent Claims</u>	
				<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>
-	=	x =	=		
HP = Highest number of total claims paid for, if greater than 20.					

<u>Indep. Claims</u>	<u>Extra Claims</u>	<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>
-	=	x =	

HP = highest number of independent claims paid for, if greater than 3.

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$260 (\$130 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

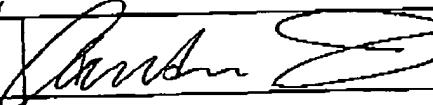
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4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): 1402 Filing a brief in support of an appeal

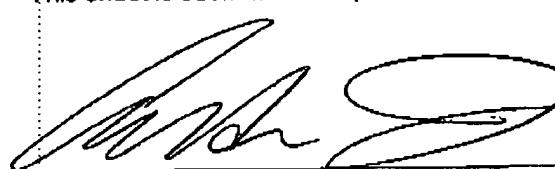
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Name (Print/Type)	C. Andrew Im
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Date	August 4, 2008

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TRANSMITTAL OF APPEAL BRIEF		Docket No. NY-THEOR 205-US1	
In re Application of: Charles Paclat			
Application No.	Filing Date	Examiner	Group Art Unit
09/975,945-Conf. #9612	October 11, 2001	A. Khatri	2191
Invention: METHOD FOR DEVELOPING BUSINESS COMPONENTS			
<u>TO THE COMMISSIONER OF PATENTS:</u>			
Transmitted herewith is the Appeal Brief in this application, with respect to the Notice of Appeal filed: <u>June 3, 2008</u> .			
The fee for filing this Appeal Brief is <u>\$ 510.00</u> .			
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<input checked="" type="checkbox"/> The Director is hereby authorized to charge any additional fees that may be required or credit any overpayment to Deposit Account No. <u>50-0624</u> . This sheet is submitted in duplicate.			
		Dated: <u>August 4, 2008</u>	
C. Andrew Im Attorney Reg. No.: 40,657 FULBRIGHT & JAWORSKI L.L.P. 666 Fifth Avenue New York, New York 10103 (212) 318-3359			

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THEOR 205.1 (10107436)

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**Docket No.: NY-THEOR 205-US1
(PATENT)**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Charles Paclat

Application No.: 09/975,945

Confirmation No.: 9612

Filed: October 11, 2001

Art Unit: 2191

For: METHOD FOR DEVELOPING BUSINESS
COMPONENTS

Examiner: A. Khatri

APPEAL BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

As required under 37 C.F.R. § 41.37(a), this brief is filed more than two months after the Notice of Appeal filed in this case on June 3, 2008, and is in furtherance of said Notice of Appeal.

The fees required under 37 C.F.R. § 41.20(b)(2) are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief contains items under the following headings as required by 37 C.F.R. § 41.37 and M.P.E.P. § 1206:

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I **REAL PARTY IN INTEREST**

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The real party interest is the assignee, BEA Systems, Inc.

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**II RELATED APPEALS, INTERFERENCES, AND JUDICIAL
PROCEEDINGS**

There are no other appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

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III STATUS OF CLAIMS

A. Total Number of Claims in Application

There are 18 claims pending in application.

B. Current Status of Claims

1. Claims canceled: NONE
2. Claims withdrawn from consideration but not canceled: NONE
3. Claims pending: 1-18
4. Claims allowed: NONE
5. Claims rejected: 1-18

C. Claims On Appeal

The claims on appeal are claims 1-18

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IV STATUS OF AMENDMENTS

Appellant did not file an Amendment After Final Rejection.

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V

SUMMARY OF CLAIMED SUBJECT MATTER

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The claimed subject matter is recited in sole independent claim 1 directed to a method for developing an Enterprise JavaBean (EJB) component by utilizing a phased approach to quickly develop and introduce products into the market, thereby reducing the time to market. (See e.g., Figs. 1-2; Specification at page 4, line 18 to page 6, line 10). The present process enables the user/developer to research business problems or domain (i.e., business project) and transforms them into EJB components. (See e.g., Figs. 1-7; Specification at page 4, line 18 to page 26, line 14).

The present method, as required in independent claim 1, comprises the step of analyzing a business domain to generate functional requirements that models the business domain. (See Specification at page 6, lines 18-21). The functional requirements define a scope of the business functionality for a new set of components, and include a summary of a list of inputs and eFunction Matrix. (See Specification at page 7, line 20 to page 12, line 17; Table 1 (an example of eFunction Matrix)). “The list of inputs can include, but is not limited, to interacting components, industry analysts, related industry standards, commercial packages, related engagements and system integrators, additional in-house resources, and eFunction Matrix.” (Specification at page 7, line 33 to page 8, line 3).

Additionally, the present method, as required in independent claim 1, comprises the step of transforming the functional requirements into an EJB component model, preferably using a UML drawing tool. (See Specification at page 12, line 19 to page 21, line 6). “The NCD [new component development] process turns the functional requirements into an object oriented model that encapsulates the data model and the process model.” (Specification at page 6, lines 22-23, page 13, lines 2-4). For example, “the NCD process uses the unified modeling language (UML) modeling tool to perform the object oriented analysis and design.” (Specification at page 12, lines 21-22). “[T]he

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NCD process refines the general descriptions generated in the analysis phase 110 into a design document from which implementation or construction of the components can be started." (Specification at page 12, line 31 to page 13, line 2). To simplify the complexity of the UML diagrams, the present invention describes relationships between objects through class stereotypes rather than inheritance. Each class stereotypes model certain behaviors and implies the presence of additional methods. The present invention utilizes the following class stereotypes: Belongings, Sessions, Entity, Configurable Entity, Business Policy, Workflow, and Smart features (e.g., SmartKey, SmartHandle, SmartValue). (Specification at page 13, line 29 to page 21, line 6).

Further, the present method, as required in independent claim 1, comprises the step of building EJB component from the EJB component model that encompass the business functionality of the business domain. (See Specification at page 21, line 8 to page 25, line 10). "The implementation phase 130 of the NCD is the implementation or building of the component themselves. In the implementation phase 130, the NCD process generates the relational mappings and deployment descriptors." (Specification at page 21, lines 9-11). The NCD process generates the classes that represent business components and "Java Doc," and compiles and deploys the components with the simplest form of persistence. Additionally, for example, the NCD process installs the Bean class and its supporting classes in the EJB server with container-managed persistence (CMP) to provide deployable components. (Specification at 21, lines 17-24).

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VI GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-16 have been rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by U.S. Patent No. 6,199,195 to Goodwin et al. (hereinafter "Goodwin"). This may be seen at page 2 of the final Office Action.

Claim 17-18 have been rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Goodwin in view of U.S. Patent 6,944,680 to Lee et al. (hereinafter "Lee"). This may be seen at page 2 of the final Office Action.

It is believed that these rejections are in error, and reversal is requested.

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VII ARGUMENT

A. §102(e) Rejection

Claims 1-16 have been rejected under 35 U.S.C. §102(e) as being allegedly anticipated by Goodwin, and will be argued together.

A rejection based on 35 U.S.C. §102 requires that the cited reference disclose each and every element covered by the claim. *Electro Medical Systems S.A. v. Cooper Life Sciences Inc.*, 32 U.S.P.Q.2d 1017, 1019 (Fed. Cir. 1994); *Lewmar Marine Inc. v. Barent Inc.*, 3 U.S.P.Q.2d 1766, 1767-68 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 1007 (1988); *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 U.S.P.Q.2D 1051, 1053 (Fed. Cir.), *cert. denied*, 484 U.S. 827 (1987). The Federal Circuit has mandated that 35 U.S.C. 102 requires no less than "complete anticipation ... [a]nticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim." *Connell v. Sears, Roebuck & Co.*, 772 F.2d 1542, 1548, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983); See also, *Electro Medical Systems*, 32 U.S.P.Q. 2d at 1019; *Verdegaal Bros.*, 814 F.2d at 631.

Appellant respectfully submits that these same claims 1-16 were also finally rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent No. 6,167,564 to Fontana et al. (hereinafter "Fontana") on August 30, 2005. Appellant filed its Appeal Brief on February 6, 2006 incorporating essentially the same arguments (as in its July 25, 2005 response to the initial Office Action dated May 23, 2005) in response to the Final Office Action of August 30, 2005.

In response to Appellant's Appeal Brief, the Examiner withdrew the final rejection based on Fontana and issued another non-final Office Action dated April 20, 2007 based on a new reference (U.S. Patent No. 7,086,065 to Yeluripati et al. (hereinafter "Yeluripati")), which was not even a prior art under 35 U.S.C. §102. Appellant filed

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response and declaration on August 15, 2007 establishing appellant's earlier reduction to practice date. In response, the Examiner withdrew his non-final Office Action of April 20, 2007 based on Yeluripati and issued yet another non-final Office Action dated October 16, 2007 based on Goodwin (the prior art reference at issue herein).

Appellant' current arguments are essentially same as its Appeal Brief of February 6, 2006 because Goodwin is no better than Fontana in teaching or suggesting all of the claim limitations of the present application. Accordingly, it is unclear to appellant why Goodwin is relevant as a prior art reference when it fails to teach or suggest any of the claimed steps of independent claim 1.

1. Goodwin Does Not Teach or Suggest Any of The Claimed Steps

The Examiner has failed to establish a case that Goodwin is an anticipatory reference under 35 U.S.C. §102(e) because Goodwin does not teach or suggest all the claim limitations of independent claim 1. In fact, appellant respectfully submits that Goodwin (as with Fontana) does not teach or suggest any of the claim steps of independent claim 1.

a. Goodwin Does Not Teach or Suggest The Claimed Step Of Analyzing

Contrary to the Examiner's assertion, Goodwin does not teach or suggest the step of "analyzing a business domain to determine functional requirements of said business domain," as required in independent claim 1. In fact, the passage cited by the Examiner (Goodwin at col. 11, lines 36-55), teaches that a meta object facility defines and manipulates a set "of meta models." Goodwin explains that a "model is a set of business objects that makes up a running software application." (Goodwin at col. 11, lines 38-40). Thus, Goodwin merely describes identifying and manipulating pre-existing software objects that make up a running software application. The present invention, however,

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analyzes business domains to determine functional requirements of the business domain. A business domain includes business problems or projects. (See, Specification at page 3, lines 14-15; Abstract). It is appreciated that one of ordinary skill in the art would not equate "meta models" with "business projects." Moreover, the present invention necessarily analyzes the business domains to determine functional requirements prior to even generating any "models." (Specification at page 7, lines 19-22; *see also*, page 7, line 19 to page 12, line 17). The very purpose of analyzing the business domain is to first determine the functional requirements to eventually generate a model. Goodwin, however, does not teach the analysis of any business domain to determine functional requirements. "To imbue one of ordinary skill in the art with knowledge of the present invention, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim of the insidious effect of hindsight syndrome, wherein that which only the inventor taught is used against the teacher." *W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983). Appellant respectfully submits that the Examiner cannot use hindsight gleaned from the present invention to contradict the clear teaching of the prior art reference to render claims unpatentable. The prior must to be judged based on a full and fair consideration of what that art teaches, not by using Appellant's invention as a blueprint for gathering various bits and modifying the pieces in an attempt to reconstruct Appellant's invention. Therefore, because Goodwin fails to teach or suggest the step of analyzing as required in claim 1 (and included in dependent claims 2-18), it follows that, contrary to the Examiner's assertion, Goodwin does not anticipate or rendered obvious claim 1, or any of dependent claims 2-18.

b. Goodwin Does Not Teach or Suggest The Claimed Step Of Transforming

Contrary to the Examiner's assertion, Goodwin does not teach or suggest the step of "transforming said functional requirements into an EJB component model," as required by independent claim 1. In fact the passage cited by the Examiner (Goodwin at

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col. 7-8, lines 53-67 and 1-5), is directed to transforming data models into code: “[t]he system . . . provides application developers with a . . . approach . . . for generating code from a data model.” (Goodwin at col. 7, lines 66-67). On the other hand, the transforming step of the present invention requires that the *functional requirements* determined from analyzing the business domain be transformed into an EJB component *model* NOT into the code resulting from the data model. The Goodwin passage is directed to the transformation of a data model to code, which requires that the model already have been generated. The transforming step of the present invention, however, is directed to transforming the functional requirements determined from analyzing the business domain into an EJB component model. The prior must to be judged based on a full and fair consideration of what that art teaches, not by using Appellant’s invention as a blueprint for gathering various bits and modifying the pieces in an attempt to reconstruct Appellant’s invention. Therefore, because Goodwin fails to teach or suggest the step of transforming as required in claim 1 (and included in dependent claims 2-18), it follows that, contrary to the Examiner’s assertion, Goodwin again does not anticipate or render obvious claim 1, or any of dependent claims 2-18.

c. Goodwin Does Not Teach or Suggest The Claimed Step Of Building

Contrary to the Examiner’s assertion, Goodwin does not teach or suggest the step of “building an EJB component in accordance with said EJB component model that encompass the business functionality of said business domain,” as required in claim 1. In fact, the passage cited by the Examiner (Goodwin at col. 12, lines, 25-25), generally explains that the repository adapter tool 312 uses “logical models from various modeling tools to generate the unified models” and that “each object within a unified model represents a unique structural feature of a software system.” (Goodwin at col. 12, lines 26). This passage does not teach building an EJB component in accordance with EJB component models that encompass the *business functionality* of a *business domain*. It is

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respectfully submitted that Goodwin is merely teaching a system for generating source code by translating logical models into unified models and then generating a plurality of templates related thereto and generating the source code therefrom. (See, e.g., Goodwin at col. 3, lines 3-26). Goodwin does not teach or suggest the claimed step of "building an EJB component in accordance with said EJB component model that encompass the business functionality of said business domain," as called for in independent claim 1. It is well established that the Examiner cannot use hindsight gleaned from the present invention to modify or reconstruct the prior art reference to render claims unpatentable. As such, because Goodwin fails to teach or suggest the step of building as required in claim 1 (and included in dependent claims 2-18), it follows that, contrary to the Examiner's assertion, Goodwin once again does not anticipate or render obvious independent claim 1, or any of dependent claims 2-18.

2. Goodwin Does Not Teach or Suggest Additional Elements Taught by Dependent Claims

Contrary to the Examiner's assertion, Goodwin does not teach or suggest the following additional elements taught by dependent claims 2, 4-7, and 10-16:

Claim 2: Goodwin nowhere discloses providing a parallel development process.

Claim 4: Goodwin does not teach or suggest functional requirements let alone functional requirements the include data and process model of the business domain.

Claim 5: Goodwin does not teach or suggest EJB component model which encapsulates the data and process model of the said business domain.

Claim 6: Goodwin does not teach or suggest generating a list of inputs wherein each input identifies a resource relating to the business domain.

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Claim 7: Goodwin does not teach or suggest generating eFunction matrix from a list of inputs.

Claim 10: Goodwin does not teach or suggest building the EJB component from at least one of the following class stereotypes: Belonging, Session, Entity, Configurable Entity, Business Policy and Workflow.

Claim 11: Goodwin does not teach or suggest mapping eXtensible Markup Language (XML) to the EJB component model.

Claim 12: Goodwin does not teach or suggest dividing the business domain into one or more sub-domains, determining functional requirements for each of the sub-domains; and transforming each of the functional requirements for the sub-domains into the EJB component model.

Claim 13: Goodwin does not teach or suggest generating deployment descriptors.

Claim 14: Goodwin does not teach or suggest generating end-user documentation, developing unit tests to test the EJB component, and generating a reference implementation of the EJB component.

Claim 15: Goodwin et al. does not teach or suggest verifying the end-user documentation to the EJB component.

Claim 16: Goodwin does not teach or suggest packaging the EJB component for deployment with container managed persistence.

Therefore, because Goodwin fails to teach or suggest any of the claimed steps of claim 1, it follows that Goodwin cannot anticipate independent claim 1. As claims 2-16 depend from independent claim 1, Goodwin cannot anticipate those claims for the same reasons it does not anticipate claim 1. Appellant submits that the Examiner has

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succumbed to the lure of prohibited hindsight reconstruction. Reconsideration is requested.

B. §103 Rejection

Claims 17-18 have been rejected under 35 U.S.C. §103 as being allegedly unpatentable over Goodwin and Lee, and will be argued together.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not be based on the Appellant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP 2143. Here, the Examiner has failed to establish a *prima facie* case of obviousness because the combination of Goodwin and Lee does not teach or suggest all the limitations of claims 17 and 18.

As explained above, Goodwin does not teach or suggest any of the steps of claim 1 and therefore of dependent claims 17 and 18. Moreover, as admitted by the Examiner, Goodwin does not teach or suggest that an EJB Component is a "Smart component having at least one of following Smart feature: SmartKey, SmartHandle and SmartValue." (October 16, 2007 Office Action at page 11). To cure this deficiency, the Examiner turns to Lee. Lee, however, does not describe the required steps of claim 1 (and incorporated into dependent claim 17 and 18): (a) analyzing a business domain to determine functional requirements of the business domain; (b) transforming the functional requirements into an EJB component model; and (c) building an EJB component in accordance with the EJB component model that encompass the business

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functionality of said business domain. As such, neither Goodwin nor Lee, independently or in combination teaches or suggests each and every element of claims 17-18. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness and has succumbed to the lure of prohibited hindsight reconstruction. Reconsideration is requested.

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VIII CONCLUSION

In view of the foregoing, Appellants respectfully submit, none of pending claims 1-18 are anticipated by Goodwin nor rendered obvious by the combination of Goodwin and Lee. Therefore, appellant requests that the Board reverse the pending grounds for rejection.

Dated: August 4, 2008

Respectfully submitted,

By 
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CLAIMS APPENDIX
(37 C.F.R. § 41.37(C)(VIII))

LISTING OF CLAIMS ON APPEAL

Claims on Appeal in Application Serial No. 09/975,945

1. (Original) A method for developing an Enterprise JavaBean (EJB) component, comprising the steps of:
 - (a) analyzing a business domain to determine functional requirements of said business domain;
 - (b) transforming said functional requirements into an EJB component model; and
 - (c) building an EJB component in accordance with said EJB component model that encompass the business functionality of said business domain.
2. (Original) The method of claim 1, further comprising the steps of:
modifying said functional requirements by a user; and
repeating the steps (b) and (c) to provide a parallel development process.
3. (Original) The method of claim 1, wherein said EJB components are extensible and configurable.
4. (Original) The method of claim 1, wherein said functional requirements include data and process model of said business domain.
5. (Original) The method of claim 4, wherein said EJB component model encapsulates the data and process model of the said business domain.

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6. (Original) The method of claim 1, wherein the step of analyzing includes the step of generating a list of inputs, each input identifying a resource that relate to said business domain.
7. (Original) The method of claim 6, further comprising the step of generating eFunction matrix from said list of inputs.
8. (Original) The method of claim 1, wherein the step of transforming transforms said functional requirements using an unified modeling language (UML) tool to generate said EJB component model.
9. (Original) The method of claim 8, wherein said EJB component model includes a plurality of EJB classes.
10. (Original) The method of claim 9, wherein the step of building builds said EJB component from at least one of the following class stereotypes: Belonging, Session, Entity, Configurable Entity, Business Policy and Workflow.
11. (Original) The method of claim 1, wherein the step of transforming includes the step of mapping eXtensible Markup Language (XML) to said EJB component model.
12. (Original) The method of claim 1, wherein the step of analyzing includes the step of dividing said business domain into one or more sub-domains and determining functional requirements for each of said sub-domains; and wherein the step of transforming transforms each of said functional requirements for said sub-domains into said EJB component model.
13. (Original) The method of claim 1, wherein the step of building includes the step of generating relational mappings and deployment descriptors.

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14. (Original) The method of claim 1, wherein the step of building includes the steps of:
 - generating end-user documentation;
 - developing unit tests to test said EJB component; and
 - generating a reference implementation of said EJB component.
15. (Original) The method of claim 14, further comprising the step of verifying said end-user documentation to said EJB component.
16. (Original) The method of claim 14, further comprising the step of packaging said EJB component for deployment with container managed persistence.
17. (Original) The method of claim 1, wherein said EJB component is a Smart component having at least one of following Smart feature: SmartKey, SmartHandle and SmartValue.
18. (Original) The method of claim 16, wherein said Smart component is an eBusiness Smart component.

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EVIDENCE APPENDIX
(37 C.F.R. § 41.37(C)(X))

None.

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RELATED PROCEEDINGS
APPENDIX
(37 C.F.R. § 41.37 (C)(X))

None.

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